

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Network Photonics, Inc.

Serial No. 75/705,082

Keith J. Berets of Cooley Godward LLP for Network
Photonics, Inc.

Michael W. Baird, Trademark Examining Attorney, Law Office
109 (Ronald R. Sussman, Managing Attorney).

Before Hanak, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Network Photonics, Inc. (applicant) seeks to register NETWORK PHOTONICS in typed drawing form for "fiber optic telecommunications systems, namely, optical cross-connects, optical add/drop multi-plexers, DWDM (Dense Wavelength Division Multiplexing) terminals, SONET switches, SONET add/drop multi-plexers and ethernet switches incorporating DWDM, optical switching and optical filtering techniques for the transport and routing of optical telecommunications signals." The intent-to-use application was filed on June 7, 1999. As originally filed, the identification of

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applicant's goods reads as follows: "fiber optic networking components and systems."

The Examining Attorney has refused registration on the basis that applicant's mark, as applied to applicant's goods, is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act. When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request an oral hearing.

A mark is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act if it immediately conveys information about a significant quality or characteristic of applicant's goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986). In determining whether a mark is merely descriptive of the goods for which registration is sought, two important propositions must be kept in mind. First, the mere descriptiveness of a mark is not determined in the abstract, but rather is determined in relation to the goods for which registration is sought. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). We

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note that at page 6 of its brief, applicant acknowledges this legal principle when it states as follows: "In making a determination as to whether a mark is descriptive or suggestive, one must consider the mark, not in the abstract, but in relation to the specific goods for which registration is sought." Second, in order to be held merely descriptive, a mark need not immediately convey information about all of the significant qualities or characteristics of the goods for which registration is sought. A term is merely descriptive if it immediately conveys information about "one of the qualities" of the goods for which registration is sought. Gyulay, 3 USPQ2d at 1010.

It is the position of the Examining Attorney "that the word PHOTONICS [is] synonymous with 'fiber optics,' and since applicant's goods [consist] of fiber optic devices for use in networking, the proposed mark merely describes the basic nature of the goods." (Examining Attorney's brief page 1). In support of his contention, the Examining Attorney relies upon dictionary definitions of the words "photonics" and "network" and newspaper stories where the term "photonic network(s)" is used in connection with goods

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of the same general type as applicant's. The Examining Attorney notes that the word "photonics" is defined as follows: "The technology that uses light particles (photons) to carry information over hair-thin fibers of very pure glass." Newton's Telecom Dictionary (15th ed. 1999). As for the word "network" the Examining Attorney notes that one of the definitions of this term is as follows: "A group or system of electric components and connecting circuitry designed to function in a specific manner." The American Heritage Dictionary of the English Language (3rd ed. 1992) (emphasis added). Finally, the Examining Attorney states that the term "fiber optics" is defined as "the science or technology of light transmission through very fine, flexible glass or plastic fibers." The American Heritage Dictionary of the English Language (3rd ed. 1992). Continuing, the Examining Attorney notes that applicant's current and original identification of goods refers to the goods as "systems" and that hence the word NETWORK in applicant's mark simply denotes that applicant's goods are a system. Furthermore, the Examining Attorney contends that the words "photonics" and "fiber optics" are essentially synonymous, and thus the PHOTONICS portion of

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applicant's mark merely denotes that applicant's goods are indeed "fiber optic telecommunication systems ... "

In addition, the Examining Attorney has made of record numerous newspaper articles where the term "photonic network(s)" - a mere reversal of applicant's mark - is used to name goods which are extremely similar to applicant's goods. For example, the Examining Attorney has made of record the following excerpt of a story appearing in the December 15, 2000 edition of the San Jose Mercury News: "What photonic networks could do for data transmission will 'completely dwarf' what they did for telephones, he said." In the November 15, 1999 edition of The Washington Post, there appears the following sentence: "Qtera is also working on an all-optical network, although 'we like to call it the purely photonic network,' says Qtera's Diner." Another example of the use of the term "photonic networks" appears in the July 30, 2000 edition of The Washington Post.

Applicant has never disputed that these uses of the term "photonic network(s)" are for products which are very similar to applicant's. Indeed, at page 6 of its brief, applicant even concedes that "the words NETWORK and

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PHOTONICS, while standing alone, have individual meaning in the fiber optic field ..." However, applicant continues at page 6 of its brief by arguing that "the combined term [NETWORK PHOTONICS] has no descriptive use or meaning in the trade."

We simply disagree. The definitions of the individual terms "network" and "photonics" are sufficient in our judgment to essentially identify the basic nature of applicant's goods, namely, "fiber optic [photonic] telecommunications systems [networks]." The fact that the term "photonic network(s)" has been widely used in connection with goods like applicant's only further conditions consumers to recognize the descriptive nature of applicant's mark which, as previously noted, is but a mere reversal of the widely used term "photonic network(s)."

Two final points merit comment. First, at page 11 of its brief and again at page 3 of its reply brief applicant argues that its mark "is not a common or generic description of any goods." We are somewhat perplexed by applicant's statements. The Examining Attorney has refused registration on the grounds that applicant's mark is merely descriptive of applicant's goods. The Examining Attorney

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has not refused registration on the grounds that applicant's mark is a generic term for its goods.

Second, at page 5 of its brief and again at page 3 of its reply brief, applicant argues that "the combination of the two words, NETWORK and PHOTONICS, results in a composite which is non-descriptive." Applicant cites the case of In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968) where the Court found that the mark SUGAR & SPICE was not merely descriptive of bakery goods because it also brought to mind a children's nursery rhyme. However, in this case, applicant has at no time offered any explanation as to what additional meaning consumers may attach to applicant's mark NETWORK PHOTONICS other than its merely descriptive meaning identifying the essential characteristics of applicant's goods.

Decision: The refusal to register is affirmed.